



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/718,952 | 11/21/2003 | William D. Hitz | BB1077 US DIV | 4183 |

23906 7590 12/29/2004

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1128
4417 LANCASTER PIKE
WILMINGTON, DE 19805

| |
|----------|
| EXAMINER |
|----------|

IBRAHIM, MEDINA AHMED

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1638

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/718,952 | HITZ ET AL. | |
| | Examiner | Art Unit | |
| | Medina A Ibrahim | 1638 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 1933.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to isolated nucleic acid encoding a soybean *myoinositol 1-phosphate synthase* and a chimeric gene comprising it, classified in class 536, subclass 23.2, for example.
- II. Claims 11-25 and 31-33, drawn to a soybean plant having specific phenotype, and a method for producing said plant classified in class 800, subclass 260, for example.
- III. Claims 26-32, drawn to a soy protein and a method for producing said soy protein, classified in class 530, subclass 370, for example.

For the invention of Group I, Applicant is also required to elect one DNA sequence from A-D.

- A) SEQ ID NO: 1 and a nucleotide sequence encoding SEQ ID NO: 2.
- B) SEQ ID NO: 15 and a nucleotide sequence encoding SEQ ID NO: 16.
- C) SEQ ID NO: 5 and a nucleotide sequence encoding SEQ ID NO: 6.
- D) SEQ ID NO: 11 and a nucleotide sequence encoding SEQ ID NO: 12.

The inventions are distinct, each from the other because of the following reasons:

Inventions A-D are not related because different inventions are drawn to structurally different sequences. Different sequences have different level of effects. In addition, the different sequences represent structurally different nucleic acid/polypeptide molecules. Since each nucleic acid sequence is disclosed in specific SEQ ID NO:, the

Art Unit: 1638

structural difference between the nucleic acid/polypeptide sequences has not been shown to be obvious. Therefore, inventions A-D are patentably distinct inventions, absent evidence to the contrary..

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the method of Group II does not necessarily require the isolated nucleic acid of Group I. While the nucleic acid of Group I can be used for the production of the plant of Group II, the nucleic acid can also be used for hybridization purposes, and the plant can be produced by a breeding method. Searching the inventions of Groups I and II together would impose serious search burden. The two inventions have a separate status in the art as shown by their different classifications.

Inventions I and III are patentably distinct products. The soy protein of Group III and isolated nucleic acid of Group I are patentably distinct inventions for the following reasons. Proteins, which are composed of amino acids, and nucleic acids, which are composed of purine and pyrimidine units, are structurally distinct molecules. The isolated nucleic acid of Group I does not y encode the soy protein of Group III. For these reasons, the inventions of Groups I and II are patentably distinct, and searching them together would impose a serious search burden. Searching the inventions of Groups I and III together would impose serious search burden. The two inventions have a separate status in the art as shown by their different classifications.

Art Unit: 1638

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The instant specification does not disclose that the soy protein can be used in the method of producing plants of Group II. The method for producing a plant of Group II and the method for producing soy protein of Group III are unrelated as they comprise distinct steps and utilize different products which demonstrates that each method has a different mode of operation. Each invention performs this function using structurally and functionally divergent material, and therefore the inventions II and III are patentably distinct. Furthermore, the distinct steps and products require separate and distinct searches. As such, it would be burdensome to search the inventions of Groups II and III together.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571)

Art Unit: 1638

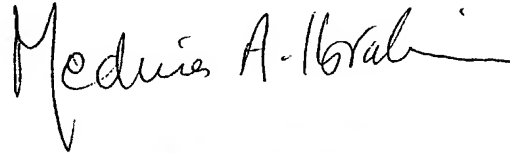
272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM. Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Amy Nelson, can be reached at (571) 272-0804.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/27/04

Mai



MEDINA A. IBRAHIM
PATENT EXAMINER